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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Paul A. Barsanti

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Intellectual Property - R440

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EXAMINER

SEAMAN, D MARGARET M

ART UNIT

PAPER NUMBER

1625

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Please find below and/or attached an Office communication concerning this application or proceeding.



### DETAILED ACTION

This application was filed 8/19/2003 and is subject to the following election/restriction requirement.

#### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 3-7 (in full) and 1-2, 36-41, 64 and 67 (in part) drawn to methods of inhibiting a serine/threonine kinase wherein the serine/threonine kinase is glycogen synthase kinase 3 wherein the compound is of structure I, classified in class 514, subclass 312+.
  - II. Claims 8-12 (in full) and claims 1-2, 36, 38-41, 64 and 67 (in part), drawn to methods of inhibiting a serine/threonine kinase wherein the serine/threonine kinase is cyclin dependent kinase 2 using the compound of structure I, classified in class 514, subclass 312+.
  - III. Claims 13-23 (in full) and 1-2, 36-41, 64 and 67 (in part) drawn to methods of inhibiting a serine/threonine kinase wherein the serine/threonine kinase is glycogen checkpoint kinase 1 wherein the compound is of structure I, classified in class 514, subclass 312+.
  - IV. Claims 24-28 (in full) and claims 1-2, 36, 38-41, 64 and 67 (in part), drawn to methods of inhibiting a serine/threonine kinase wherein the

serine/threonine kinase is ribosomal S6 kinase 2, classified in class 514, subclass 312+.

- V. Claims 29-35 (in full) and 1-2, 36-41, 64 and 67 (in part) drawn to methods of inhibiting a serine/threonine kinase wherein the serine/threonine kinase is PAR-1 wherein the compound is of structure I, classified in class 514, subclass 312+.
- VI. Claims 1-2, 36-41, 64 and 67 (in part) drawn to methods of inhibiting a serine/threonine kinase wherein the serine/threonine kinase is other than in groups I-V wherein the compound is of structure I, classified in class 514, subclass 312+.
- VII. Claims 44-45 (in full) and claims 42-43 and 52 (in part), drawn to methods of inhibiting a tyrosine kinase using a structure of formula I wherein the tyrosine kinase is cell cycle division 2 kinase, stem cell factor receptor, or stem cell tyrosine kinase 1, classified in class 514, subclass 312+.
- VIII. Claims 46-47 (in full) and claims 42-43 and 52-53 (in part), drawn to methods of inhibiting a tyrosine kinase using a structure of formula I wherein the tyrosine kinase is Fyn oncogene, classified in class 514, subclass 312+.
- IX. Claims 48-49 (in full) and claims 42-43 and 52-53 (in part), drawn to methods of inhibiting a tyrosine kinase using a structure of formula I wherein the tyrosine kinase is Lck, classified in class 514, subclass 312+.

- X. Claims 50-51 (in full) and claims 42-43 and 52 (in part), drawn to methods of inhibiting a tyrosine kinase using a structure of formula I wherein the tyrosine kinase is Tie-2, classified in class 514, subclass 312+.
- XI. Claims 42-43 and 52 (in part), drawn to methods of inhibiting a tyrosine kinase using a structure of formula I wherein the tyrosine kinase is other than cited in groups VII-X, classified in class 514, subclass 312+.
- XII. Claims 54-62, 64 and 67, drawn to methods of inhibiting a serine/threonine kinase using a structure of formula IB, classified in class 514, subclass 210+.
- XIII. Claims 63, 66 and 68 (in part), drawn to compounds of formula I, classified in class 546, subclass 153+.
- XIV. Claims 63, 66 and 68 (in part), drawn to compounds of formula IB, classified in class 544, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I-VI and XII are related as methods which share an alleged common utility of inhibiting serine/threonine kinase but the common utility is not linked to a substantial structural feature. The products in this relationship are distinct if either or both of the following can be shown: (1) that the methods encompass embodiments that are not required to perform the common utility or (2) that the methods as claimed can be used to perform another utility. In this case, the compounds needed to practice them

methods of group XII are not the same compounds needed to practice the methods of groups I-VI.

3. Inventions I-VI and VII-XI are related as methods which share an disclosed common utility linked to a substantial structural feature. The methods in this relationship are distinct if either or both of the following can be shown: (1) that the methods encompass embodiments that are NOT required to perform the common utility or (2) that the methods as claimed encompass embodiments that are NOT required to have the substantial structural feature. In this case, the methods using the same compounds are different methods, namely inhibiting tyrosine kinase and inhibiting serine/threonine kinase.

4. Unpatentability of the group I methods would not necessarily imply unpatentability of the group II-XI methods because the methods are so divergent that a reference providing a 35 U.S.C. §102(b) rejection on a member of one group would not render a member of the other groups obvious under 35 U.S.C. §103. Applicant has the different groups inhibiting different types of kinases. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

5. Unpatentability of the group XIII compounds would not necessarily imply unpatentability of the group XIV compounds because the compounds are so divergent that a reference providing a 35 U.S.C. §102(b) rejection on a member of one group would not render a member of the other groups obvious under 35 U.S.C. §103. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.


6. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 730am-4pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
D. Margaret Seaman  
Primary Examiner  
Art Unit 1625

dms